



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,684	12/08/2003	Edward J. Vasei	81079 7304	3287

22242 7590 10/06/2004

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

THOMSON, MICHELLE R

ART UNIT PAPER NUMBER

3641

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/731,684

Applicant(s)

VASEL ET AL.

Examiner

Michelle (Shelley) Thomson

Art Unit

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention II, claims 13-25 in the reply filed on 8/9/04 is acknowledged.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for launching the plurality of projectiles must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Where the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means-plus-function, applicant must clarify the disclosure to **explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim elements and equivalents thereof.** (See MPEP 2181).

Correction of the following is required: applicant must clarify the disclosure to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the means for launching the plurality of projectiles recited in the claim elements and equivalents thereof.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 22-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a system wherein a cartridge includes means comprising a projection cartridge to launch the projectile, does not reasonably provide enablement for a means for launching the plurality of projectiles and specifically wherein the means for launching launches at least a sub-set of the plurality of the projectiles within a limited time to contact a target along a path across the target. The specification does not enable any person skilled in the art to which it

Art Unit: 3641

pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 13-16, 18-21, and 23-25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Vasel et al. (US Patent # 6,543,365)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate

Art Unit: 3641

showing under 37 CFR 1.131. Vassel et al. discloses the claimed projectile system for use in delivering a substance to a target comprising a projectile comprising a first part, a second part that is at least partially hollow wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical (Figures 16-19); an inhibiting substance (reference 1704) contained within the volume; stabilizing fins (reference 1802) secured with the second part along an exterior of the second part; wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target (Figures 23 and 24). Wherein the first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume (Figure 17A). Wherein the second part tapers to a smaller diameter away from the first part, and the second part has a length that is greater than a width of the first part, further comprising additional stabilizers positioned on the exterior of the second part (Figure 19). Further comprising a shell, an ignitable substance positioned within the shell wherein the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance and a propulsion block positioned within the shell wherein the projectile is positioned within the shell adjacent the propulsion block and the ignitable substance includes primer positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell (Figure 39B and columns 49 and 50). The inhibiting substance includes capsaicin. The system further comprising a cartridge coupled with the second part wherein the cartridge includes means for launching the projectile. The system further comprising a plurality of projectiles and a means for launching the plurality of projectiles which

Art Unit: 3641

launches at least a sub-set of the plurality of projectiles within a limited time to contact a target along a path across the target (columns 12 and 13).

8. Claims 13-16, 18, 19, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Abbott et al. (US Patent # 3,650,213). Abbott et al. discloses the claimed projectile system for use in delivering a substance to a target comprising a projectile (reference 31) comprising a first part (reference 33), a second part (reference 35) that is at least partially hollow wherein the second part is secured with the first part to seal the hollow portion defining a volume, wherein the projectile is non-spherical (Figure 4); an inhibiting substance, CS or CN, (reference 32) contained within the volume; stabilizing fins (reference (reference 39) secured with the second part along an exterior of the second part; wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target (column 1, lines 5-10).

Wherein the first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume (Figure 3). Wherein the second part tapers to a smaller diameter away from the first part, and the second part has a length that is greater than a width of the first part (Figure 3), further comprising additional stabilizers (additional fins 39) positioned on the exterior of the second part. Further comprising a shell (reference 21), an ignitable substance (means for launching the projectile) (reference 51) positioned within the shell wherein the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance and a propulsion block (reference 41) positioned within the shell wherein the projectile is positioned within the shell adjacent the propulsion block and the ignitable substance includes

Art Unit: 3641

primer (reference 29) positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell.

9. Claims 13-17, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tougeron et al. (US Patent # 5,565,649). Tougeron et al. discloses the claimed projectile system for use in delivering a substance to a target comprising a projectile comprising a first part (references 2, 62), a second part (reference 4) that is at least partially hollow wherein the second part is secured with the first part to seal the hollow portion defining a volume (Figures 1, 3, 4, and 6), wherein the projectile is non-spherical; an inhibiting substance (reference 8, 61) contained within the volume; stabilizing fins (reference 32, column 3, lines 60-65) secured with the second part along an exterior of the second part; wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target (column 1, lines 45-55). Wherein the first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume. Wherein the second part tapers to a smaller diameter away from the first part, and the second part has a length that is greater than a width of the first part, further comprising additional stabilizers (additional stabilizing surfaces 32) positioned on the exterior of the second part. Wherein the first part is reusable and further comprising support structures (reference 59). The system further comprising a cartridge (reference 14) coupled with the second part wherein the cartridge includes means for launching the projectile (column 3, lines 1-35). Wherein the first part is a generally non-frangible nose section, the body part is the rupturable part that releases the product contained.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. as applied to claims 13, 18, and 19 above. Abbott et al. discloses the claimed invention except for the system comprising a plurality of the projectiles. It is obvious to one of ordinary skill in the art that a plurality of the projectiles could be provided since it has been held that mere duplication of a device involves only routine skill in the art and Abbott et al. discloses the system for percussive firing and firing system capable of firing a plurality of cartridges are well known.

12. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. as applied to claims 13, 18, 19, 23 and 24 above, and further in view of Pinkney (US Patent # 5,217,708). Although Abbott et al. does not expressly disclose the inhibiting substance comprising capsaicin, Pinkney does. Abbott et al. discloses the inhibiting substances as CS or CN but does not expressly disclose the inhibiting substance comprising capsaicin. Pinkney teaches capsaicin as an effective and preferable substitute for CS and CN as a lachrymator because it is a natural material as opposed to a man-made chemical. Abbott et al. and Pinkney are analogous art because they are from similar problem solving areas: riot control. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the capsaicin as taught by Pinkney for the CS or CN as suggested by Abbott et al. The

Art Unit: 3641

suggestion/motivation for doing so would have been to obtain a riot control projectile that was more effective and friendlier to the environment.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Buzick (US Patent # 5,936,190), Abbott (US Patent # 3,848,532), Halland (US Patent # 1,920,257), LaCosta (US Patent # 3,738,271), Prentice et al. (Design Patent # 348,907), Laronge (US Patent # 6,220,918), and Tucker (US Patent # 3,983,817).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Thomson whose telephone number is 703.306.4176. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 703.306.4198. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mrt

